

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THEODORE D. JOHNSON, JR.

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Appeal No. 2000-0873  
Application No. 08/975,983

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HEARD: February 22, 2001

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Before ABRAMS, STAAB and BAHR, *Administrative Patent Judges*  
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 44-48, 55-76, 79, 82, 85, 88, 91, 94, 97 and 100. Claims 89, 90, 92, 93, 95, 96, 98 and 99 have been allowed. Dependent claims 77, 78, 80, 81, 83, 84, 86 and 87 have been objected to as depending from rejected claims, but otherwise indicated as being allowable if rewritten in independent form to include the limitations of the base claims

Appeal No. 2000-0873  
Application No. 08/975,983

from which they

depend. Claims 1-19, 22-39 and 42, 43, 49-54 and 101-112, the only other claims remaining in the application, have been withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as not being readable in the elected invention.

Appellant's invention pertains to a kit and method for "permit[ting] a non-artist to easily transfer outlines of works of art, cartoon characters, or any graphic images, to surfaces of objects such as walls, ceilings, or doors" (specification, page 4). Independent claims 56 and 44, copies of which are found in an attachment to appellant's brief, are representative of the claimed kit and method, respectively.

The references applied by the examiner in the final rejection are:

Milne	3,284,927	Nov. 15, 1966
Canning et al. (Canning) 1973	3,760,973	Sep. 25,
DePauw	3,815,265	Jun. 11, 1974
Dowzall et al. (Dowzall) 1990	4,941,520	Jul. 17,

Mayer, *"The Artist's Handbook Of Materials and Techniques"*, fourth ed., published by The Viking Press, New York (August,

Appeal No. 2000-0873  
Application No. 08/975,983

1986).

*Ralph Lauren Brochure* (Admitted Prior Art).

The following rejections are before us for review:

(a) claims 44-48, 55-63 and 69-72, rejected under 35  
U.S.C.

§ 112, first paragraph, "as containing subject matter which  
was not described in the specification in such a way as to  
reasonably convey to one skilled in the relevant art that the  
inventor(s), at the time the application was filed, had  
possession of the claimed invention" (final rejection, page  
3)<sup>1</sup>;

(b) claims 44-47, 55-63 and 69-72, rejected under 35  
U.S.C. § 103 as being unpatentable over Mayer in view of Milne  
and DePauw;

(c) claim 48, rejected under 35 U.S.C. § 103 as being

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<sup>1</sup> Although the statement of this ground of rejection does not appear in  
the examiner's answer, it is clear from the record (see, for example, pages  
13-14 of the brief and pages 6-7 of the answer) that it is being maintained on  
appeal.

Appeal No. 2000-0873  
Application No. 08/975,983

unpatentable over Mayer in view of Milne, DePauw and Canning;

(d) claims 64 and 73, rejected under 35 U.S.C. § 103 as being unpatentable over Mayer in view of Milne, DePauw and Dowzall;

(e) claims 65-68 and 74-76, rejected under 35 U.S.C. § 103 as being unpatentable over Mayer in view of Milne, DePauw, Dowzall and Canning; and

(f) claims 79, 82, 85, 88, 91, 94, 97 and 100, rejected under 35 U.S.C. § 103 as being unpatentable over Mayer in view of Milne, DePauw, Dowzall and Ralph Lauren Paints.

In addition to seeking review of the foregoing rejections, appellant has raised as issues in the appeal the propriety of (1) the examiner's withdrawal of claims 101-112 from consideration pursuant to 37 CFR § 1.142(b) and (2) the examiner's objection to the drawings for not showing "the manner in which the amounts of paint are specified and the label showing the plurality of paints" (final rejection, sentence spanning pages 2-3). Under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary

Appeal No. 2000-0873  
Application No. 08/975,983

examiner to reject claims. We exercise no general supervisory power over the examining corps, and decisions of primary examiners withdrawing claims from consideration and objecting to the content of drawings are not subject to our review. See MPEP §§ 1002.02 and 1201; *In re Hengehold*, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971) (restriction requirement is a procedural matter not reviewable by appeal);

*compare In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967) (matters within the examiner's discretion, such as refusal to enter amendment after final rejection, are reviewable by petition to the Commissioner (now, Director)). Thus, the relief sought by appellant would have properly been presented by a petition to the Director under 37 CFR § 1.181, and we shall not review or further discuss the examiner's actions in these matters.

Appellant's arguments on pages 16-18 of the brief regarding the Warman patent, of record, are also noted. These

Appeal No. 2000-0873  
Application No. 08/975,983

arguments are inappropriate and will not be considered because the examiner is not relying on this patent in rejecting the appealed claims. See page 9 of the answer.

*Rejection (a)*

The rejection of claims 44-48, 55-63, 69-72 under the first paragraph of 35 U.S.C. § 112 is founded on the examiner's reading of these claims as requiring that the tangible medium that specifies the amounts of paint needed for each paint is a medium that is separate and distinct from the color/shading matching card. According to the examiner (final rejection, page 3), the

original disclosure does not describe such a separate tangible medium for the amounts of paint needed.

With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112, the test for determining compliance therewith "is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the

Appeal No. 2000-0873  
Application No. 08/975,983

later *claimed* subject matter, rather than the presence or absence of literal support in the specification for the claim language." *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (emphasis added).

At the outset, it is our view that several of the claims of this grouping (e.g., method claim 44) do not require a tangible medium that specifies the amounts of paint needed which is separate from a color/shading matching card. Accordingly, the examiner's § 112, first paragraph, rejection fails at the outset with respect to such claims because it is not directed to the *claimed* subject matter. In any event, assuming *arguendo* that the claims do require a medium that specifies the amounts of paint needed which is separate from the medium that specifies the

color/shading of the paints, we find support for such an arrangement at page 11, lines 9-19, of the specification, wherein it is stated that the color/shading matching card 120 may include the actual color of the paint and amounts needed

Appeal No. 2000-0873  
Application No. 08/975,983

for each type of paint, *or alternatively*, the information concerning color and/or shading can be provided on *another* tangible medium such as on the first side 132a of sheet 132 or on a video tape or audiotape. Clearly, the described alternative arrangement of providing information concerning color and/or shading on *another* tangible medium relative to the card 120 would result in a tangible medium (i.e., card 120) specifying amounts of paint needed that is separate from a tangible medium (sheet 132, a video tape or audiotape) that provides color/shading information.

Accordingly, we shall not sustain the standing rejection of claims 44-48, 55-63, 69-72 under the first paragraph of 35 U.S.C. § 112.

*Rejection (b)*

Independent claim 44 is directed to a method including the step of "specifying amounts needed for each of the plurality of paints of the mural." Independent article claim 56 is directed



to a kit wherein "a third tangible medium is provided which specifies amounts needed for each of the plurality of paints of the mural." The other method and article claims in this grouping include similar claim language. In rejecting the claims of this grouping as being unpatentable over Mayer in view of Milne and DePauw, the examiner has advanced several theories as to why this claim recitation does not patentably distinguish over the applied prior art.

First, it appears to be the examiner's view (final rejection, pages 5-6) that the disclosure in DePauw of mixing specified proportions of primary colors and black and white to create secondary colors is sufficient to meet this limitation. However, specifying the proportion of a color to be mixed to achieve another color, as taught by DePauw, relates to the *relationship between quantities* such that if the one color varies then the others vary in an amount dependent on the first, whereas the claims call for specifying the amounts (i.e., *total quantities*) needed for each of the plurality of paints of the mural. Since specifying proportions of colors to be used is not the same as specifying amounts of paints to

Appeal No. 2000-0873  
Application No. 08/975,983

be used, the examiner's first theory of the obviousness is not well taken.

Second, the examiner notes that Mayer discloses a process for painting murals that includes providing a small sized picture of the completed version of mural. The examiner posits that "the completed picture of the mural would also be sufficient to read on specifying . . . the amount of paint to be used" (final rejection page 11). The examiner further opines that

the amounts of paint to be used can be seen and extrapolated from the drawing of the completed version of the mural. Since not [sic, no] specific discussion with regard to the units or means for measuring these amounts have been provided, certainly a basic amount can be understood by an ordinarily skilled person (i.e. a lot or a little), as to relative and approximate amounts of paint to be used, based on the amount needed as shown on the completed picture of the mural. [Final rejection, page 12.]

We do not consider that the ability of a person to look at a downsized model of the final mural and make a determination that either "a lot" or "a little" of a particular color is to be used is sufficient to satisfy the claim recitation of specifying the amounts needed for each of

the plurality of paints of the mural. As aptly pointed out by appellant on page 19 of the brief, what the examiner seems to be saying is that it would have been obvious to "figure out" the amounts needed from the downsized model of the final mural. However, like appellant, we

simply do not agree with this conclusion. From our perspective, the combined teachings of the applied references do not, either expressly or implicitly, suggest specifying the amounts (i.e., *total* quantities) needed for each of the plurality of paints of the mural. Thus, the examiner's second theory of obviousness also is not well taken.

Third, the examiner appears to be of the view (see, for example, final rejection, page 12) that specifying the amounts of paint needed for each of the paints of the mural has not been disclosed by appellant as being a critical or essential feature of the invention, and that accordingly this feature cannot be relied upon to patentably distinguish over the prior art. However, this theory fails at the outset because criticality is not a requirement of patentability. See *W. L.*

Appeal No. 2000-0873  
Application No. 08/975,983

*Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Finally, the examiner contends that specifying the amounts of paint to be used "would be the mere statement of that which could be obviously, if not inherently, known to an ordinarily skilled artisan, certainly not a patentably [sic] distinct and

unique feature over the prior art" (answer, page 10).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.* In the present case, the examiner has failed to advance any factual

Appeal No. 2000-0873  
Application No. 08/975,983

basis to support the conclusion that it would have been obvious to one of ordinary skill in the art to modify the applied prior art references in a manner which would have resulted in specifying amounts needed for each of the plurality of paints of the mural. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Here, the references applied by the examiner contains no such suggestion.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 44-47, 55-63 and 69-72 as being unpatentable over Mayer in view of Milne and DePauw.

*Rejections (c) and (d)*

Claim 48 stands rejected as being unpatentable further in

Appeal No. 2000-0873  
Application No. 08/975,983

view of Canning, and claims 64 and 73 stand rejected as being unpatentable further in view of Dowzall. Each of these claims, through their dependency, includes recitations concerning specifying amounts of paint needed for each of the plurality of paints of the mural. We have carefully reviewed the Canning and Dowzall references additionally relied upon in these rejections but find nothing therein which makes up for the deficiencies of Mayer, Milne and DePauw in this regard. Accordingly, we also shall not sustain the standing § 103 rejections of these claims.

*Rejection (e)*

Claims 65-68 and 74-76 stand rejected as being unpatentable over Mayer in view of Milne, DePauw, Dowzall and Canning.

Claims 65, 68 and 74 of this grouping include recitations about specifying amounts of paint needed for each of the plurality of paints of the mural, which, as indicated above,

are not taught by the applied references. Thus, the standing

§ 103 rejections of claims 65, 68 and 74 shall not be sustained.

Claims 66, 67, 75 and 76, on the other hand, do *not* include any recitation about specifying amounts of paint needed to paint the mural, and thus the rejection of these claims requires further analysis.<sup>2</sup> With respect to these claims, appellant's arguments in favor of patentability are found on page 14 of the brief, where appellant presents arguments directed against the basic combination of Mayer, Milne and DePauw, and on pages 15-16 of the brief, where appellant presents arguments directed against the examiner's further reliance on Dowzall and Canning. We note at the outset that these arguments are very general. For example, on page 14 of the brief, appellant notes the claim limitations "providing instructions . . . on how to paint a mural" and "providing a picture of a completed version of the mural," (emphasis original) and merely argues that the examiner's

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<sup>2</sup> Since claims 66, 67, 75 and 76 do not contain any recitation about specifying amounts of paint needed to paint the mural, appellant's extensive arguments on pages 18-22 regarding that terminology do *not* apply. Likewise, appellant's argument in section XII of the brief spanning pages 22 and 23 do *not* apply to claims 66, 67, 75 and 76 because said claims do not contain the "color samples from a paint manufacturer" terminology argued in section XII.

basic combination of Mayer, Milne and DePauw "does not satisfy these limitations and other[] [unspecified limitations] of the claims." On pages 15-16 of the brief, appellant's argument mirrors the above argument in that appellant merely contends that "[n]one of the combination of Mayer, Milne, Depauw, Dowzall and/or Canning et al. disclose instructions for painting a mural or discloses a completed picture of the mural, required by claims 65, 66-68, and 74-76" (emphasis in original). These arguments are not persuasive.<sup>3</sup>

The Mayer reference applied in the rejection of these claims pertains to mural painting. Among other things, Mayer informs the artisan that the technical requirements for mural painting are similar to those for oil and tempera easel picture painting (page 316), that the mural painter, before commencing work, assembles "a rather complete set of plans,

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<sup>3</sup> We are aware that claims 66, 67, 75 and 76 contain limitations regarding providing measuring cups having tick marks and sealable lids for said cups. However, appellant does not argue these limitations as differences and thus it will be assumed that they do not patentably distinguish over the examiner's reference combination. Cf. *In re Baxter Travenol Labs*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board).



usually including a visualization of the entire painting drawn to scale in full color" (pages 331-332), and that the scale drawing is then enlarged and the image transferred to the wall (page 332).

The Milne reference is directed to a picture painting kit, and in particular to a picture painting kit that allows an untrained person in the production of fully-colored paintings a degree of artistic license by providing that the user mix paints to achieve another desired color. Milne's kit includes a fully saturated color reproduction 27 of a scene to be painted by the user, an unsaturated color reproduction 31 of the same scene, a plurality of paint tubes 36, and instructions 37 "which describe the manner of mixing colours and the method of applying such colours to the reproduction 31" (column 3, lines 23-25).

Based on these prior art teachings, we consider that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to adopt the picture painting kit of Milne to allow an untrained person to reproduce a scene as a large-scale wall mural in order to

Appeal No. 2000-0873  
Application No. 08/975,983

enhance the appearance and aesthetics of a building structure, suggestion for the above being found in the express teachings of Mayer that the technical requirements for mural painting are similar to those for easel picture painting, and in the implicit teachings of Mayer regarding the artistic value of mural paintings. Based on the

fact that Milne's kit includes instruction on how to proceed in reproducing the easel picture, it is our view that in so adopting Milne's kit, the resulting kit would provide instructions on how to paint a mural. Furthermore, based on the fact that both Milne and Mayer teach providing a picture of the completed version of the finished picture, it is also our view that in so adopting Milne's kit, the resulting kit would provide a picture of a completed version of the mural. Appellant's arguments to the contrary are not persuasive because they do not take into account what the *combined* teachings of the references would have suggested to one of

Appeal No. 2000-0873  
Application No. 08/975,983

ordinary skill in the art.<sup>4</sup>

Accordingly, as argued, we shall sustain the examiner's rejection of claims 66, 67, 75 and 76 as being unpatentable over Mayer in view of Milne, DePauw, Dowzall and Canning.

*Rejection (f)*

Claims 79, 82, 85, 88, 91, 94, 97 and 100 stand rejected as being unpatentable over Mayer in view of Milne, DePauw, and Ralph Lauren Paints.

Claims 79, 82, 85 and 88 of this grouping include recitations about specifying amounts of paint needed for each of the plurality of paints of the mural. We have reviewed the Ralph Lauren Paints reference additionally relied upon by the examiner in this ground of rejections, and conclude that it does not make up for the deficiencies of Mayer, Milne and DePauw in this regard. Accordingly, the standing § 103 rejections of claims 79, 82, 85 and 88 shall not be sustained.

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<sup>4</sup> *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not . . . that the claimed invention must be expressly suggested in any one or all of the references. Rather, it is what the combined teachings of the references would have suggested to those of ordinary skill in the art.")

Appeal No. 2000-0873  
Application No. 08/975,983

Claims 91, 94, 97 and 100, on the other hand, do not include any recitation about specifying amounts of paint needed to paint the mural, and thus the rejection of these claims requires further analysis.<sup>5</sup> With respect to these claims, appellant's argument in favor of patentability is found on page 16 of the brief, and is set forth as follows in its entirety:

The Ralph Lauren Reference does not refer to murals. There is no indication of painting a wall with a plurality of colors. Ralph Lauren deals with textures to apply to a wall not mural images.

Thus, none of the combination of Mayer, Milne, Depauw, and Ralph Lauren discloses instructions for painting a mural or discloses a completed picture of the mural, required by claims 65, 66-68, and 74-76.

Clearly, the combination of Mayer, Milne, Depauw and Ralph Lauren does not satisfy the limitations of claims 65, 66-68, and 74-76.

These arguments are not well taken.

Representative claim 94 is directed to a kit comprising (1) instructions in a first tangible medium on how to paint a mural on a wall, (2) a picture of a completed version of the

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<sup>5</sup> As with claims 66, 67, 75 and 76, the arguments on pages 18-23 of appellant's brief do not apply to claims 91, 94, 97 and 100.

mural, (3) a plurality of color samples provided in a second tangible medium distinct from the picture and having the same colors as the paints of the mural, and (4) a third tangible medium identifying a name of a paint manufacturer line of paints for use in painting the mural.

As to items (1) and (2) of the claimed kit, for the reasons discussed above in connection with the rejection of claims 66, 67, 75 and 76, it would have been obvious in view of Mayer to adopt the picture painting kit of Milne to allow a user to reproduce a scene as a large-scale wall mural, and in the process provide a kit having items (1) and (2).

Concerning item (3), DePauw relates to a device for teaching color mixing in a coordinated manner, and includes a mixing tray 10, a plurality of paints in squeeze bottles, and a mixing chart (Figure 6) having a

color scale and indicia thereon for demonstrating how colors can be mixed to obtain other colors. Based on Milne's teaching of including in the kit instructions that inform the user of how to mix paints (column 3, lines 30-35), and

Appeal No. 2000-0873  
Application No. 08/975,983

DePauw's teaching of providing in its color mixing kit a mixing chart having a color scale and indicia thereon to facilitate mixing colors, it would have been further obvious to provide item (3) in Milne's kit to achieve DePauw's purpose of facilitating the mixing of colors. As to item (4), as is apparent from our reproduction of appellant's arguments in favor of the patentability of the claims of this grouping, appellant has not argued item (4) with any reasonable degree of specificity as a basis of distinction over the applied prior art. In any event, we are in accord with the examiner's bottom line determination that it would have been obvious to provide item (4) in a mural painting kit since, from our perspective, it would have been obvious to provide the paint tubes 36 of Milne with indicia as to their manufacturer (e.g., brand name), which indicia would satisfy the "third tangible medium" limitation of claim 94 as broadly claimed.

For these reasons, we shall sustain the examiner's rejection of claim 94 as being unpatentable over Mayer in view

Appeal No. 2000-0873  
Application No. 08/975,983

of Milne, DePauw and Ralph Lauren Paints. We also shall sustain the examiner's rejection of claims 91, 97 and 100 since appellant as not separately argued these claims apart from claim 94. *See, for example, In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991); *In re Kroekel*, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986).

*Summary*

The rejection of claims 44-48, 55-63 and 69-72, under 35 U.S.C. § 112, first paragraph, is reversed.

The rejections of claims 44-48, 55-76, 79, 82, 85, 88, 91, 94, 97 and 100 under 35 U.S.C. § 103 are reversed as to claims 44-48, 55-65, 68-74, 79, 82, 85 and 88, but are affirmed as to claims 66, 67, 75, 76, 91, 94, 97 and 100.

The decision of the examiner is affirmed-in-part.

Appeal No. 2000-0873  
Application No. 08/975,983

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

*Affirmed-in-part*

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JENNIFER D. BAHR	)	
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Appeal No. 2000-0873  
Application No. 08/975,983

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